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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/120,664	07/22/1998	DAVID F. GAVIN	101792-100	2454

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WIGGIN AND DANA LLP
ATTENTION: PATENT DOCKETING
ONE CENTURY TOWER, P.O. BOX 1832
NEW HAVEN, CT 06508-1832

EXAMINER

GROSS, CHRISTOPHER M

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/120,664

Applicant(s)

GAVIN ET AL.

Examiner

Christopher M. Gross

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 18 July 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,38 and 40-46.
Claim(s) withdrawn from consideration: 47-49.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: see continuation sheet.

PETER PARAS, JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600



PTO-303

CONTINUATION OF 3.

The amendment to claim 42, filed 7/18/2006, inserting the limitations 'with the proviso that when the metal is copper' requires further search and consideration. The limitation was not searched earlier and the amendment changes the scope of the claim.

Furthermore, whereas said amendment appears to overcome the rejection of record under 35 USC 112 1st paragraph (new matter) it appears the claim no longer reads on the species (i.e. zinc pyrithione) elected in the response entered 5/27/1999.

CONTINUATION OF 11.

The reconsideration is predicated on entry of the proposed amendments after final, however the amendments will not be entered (see continuation of 3 above).

CONTINUATION OF 13.

Response to Arguments

The claims entered 7/18/2006 would have been rejected on the grounds and art of record for the following reasons.

Claims 1,38,40,41,43 and 44 were and currently remain rejected under 35 USC § 102 over Morris et al (US Patent 5,916,947) for the reasons set forth the previous office actions, mailed on 5/3/2005 and 1/19/2006.

Applicant's arguments (7/18/2006) p 6-7, have been fully considered but they are not persuasive because the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what

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seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”) (see MPEP 2145 I.) In the instant case, Applicant’s counsel argues coating or subliming zinc pyrithione would not provide the claimed invention because transchelation will not occur, however counsel does not provide objective evidence establishing this as a fact.

Claims 1,38,40,41,43 and 44 were and currently remain rejected under 35 USC § 102 over Hani (US Patent 6,162,446) for the reasons set forth the previous office actions, mailed on 5/3/2005 and 1/19/2006.

Applicant argues (7/18/2006) p 8 that the composition of Hani is a discrete particle of zinc pyrithione and does not explicitly disclose the physical formation of a “composite” particle (e.g. shell/core structure). This is not found persuasive for the following reasons.

The Examiner notes that the limitation that the core and shell differ in composition is not set forth in the claims, which are drawn to a core comprising a metal and shell containing a metal pyrithione.

The Hani reference discloses a composition in particle form, which comprises the same components (zinc and pyrithione) which possesses the same presently claimed utility (e.g. biocidal). Therein, the particle complex of Hani, which possesses ingredients within the scope of the presently claimed invention, would *inherently* possess the same physical parameters (e.g. core and shell).

According to MPEP 2112.01, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, since Hani teaches the identical or substantially identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claims 1,38,40,41,43 and 44 were and currently remain rejected under 35 USC § 102 over Mohseni et al (US Patent 6,465,015) for the reasons set forth the previous office actions, mailed on 5/3/2005 and 1/19/2006.

Applicant argues (7/18/2006) p 8 that the composition of Mohseni et al is a discrete particle of zinc pyrithione and does not explicitly disclose the physical formation of a "composite" particle (e.g. shell/core structure). This is not found persuasive for the following reasons.

The Examiner notes that the limitation that the core and shell differ in composition is not set forth in the claims, which are drawn to a core comprising a metal and shell containing a metal pyrithione.

The Mohseni et al reference discloses a composition in particle form, which comprises the same components (zinc and pirithione) which possesses the same presently claimed utility (e.g. biocidal). Therein, the particle complex of Mohseni et al, which possesses ingredients within the scope of the presently claimed invention, would *inherently* possess the same physical parameters (e.g. core and shell).

According to MPEP 2112.01, where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore, since Mohseni et al teach the identical or substantially identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Claims 1,38 and 40-46 were and currently remain rejected under 35 USC § 103 over any of Morris et al (US Patent 6,456,015), Hani et al (US Patent 6,162,446) or Mohseni et al (US Patent 6,456,015) in view of Kappock et al (US Patent 5,518,774) for the reasons set forth the previous office actions, mailed on 5/3/2005 and 1/19/2006.

Applicant's arguments (7/18/2006) p 9, have been fully considered but they are not persuasive for the following reasons.

The arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.") (see MPEP 2145 I.) In the instant case, Applicant's counsel argues coating or subliming zinc pyrithione per Morris et al would not provide the claimed invention because transchelation will not occur, however counsel does not provide objective evidence establishing this as a fact.

Furthermore, Applicant has addressed Morris et al as teaching away from the claimed invention, however, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).